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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,238	02/07/2000	Gregory A. Stobbs		9957

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EXAMINER
WONG, LESLIE

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Office Action Summary	Application No.	Applicant(s)
		09/499,238	STOBBS ET AL.
		Examiner	Art Unit	
		Leslie Wong	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _06 August 2004_.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-7,11-22,31 and 32_ is/are pending in the application.

    4a) Of the above claim(s) _8-10,23,24 and 26-30_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-7,11-22,31 and 32_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _07 February 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _06 Aug. 2004_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1.   Applicants' Information Disclosure Statement, filed 06 August 2004, has been

received, entered into the record, and considered. See attached form PTO-1449.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

3.   Claims 1-2, 4-7, 11-12, 14-16, 18-22, and 31-32 are rejected under 35 U.S.C.

103(a) as being unpatentable over **Snyder et al. ("Snyder")** (U.S. Patent 6,038,561) in

view of **Risen, Jr. et al. ("Risen")** (U.S. Patent 6,018,714).

Regarding claim 1, **Snyder** teaches a method and computer implemented patent

portfolio analysis method comprising:

a).   retrieving a corpus of patent information from a database, said information

including multiple claims from a plurality of patent documents (col. 4, lines 3-7 and lines

8-18);

Snyder further teaches analysis of structured documents such as claims within

patents, accurately compare claims from two different patents in attempt to identify both

the scope and references of the claims. Additionally, the system translate a set of

claimlist text files which have been preprocessed into a single "mapit.wordvec.*.extr"

file. This file consists of a list of each unique term in the original claimlist files followed

by a count of the number of occurrences of that term for each document (col. 11, lines

22-28; col. 23, lines 42-45).

Snyder does not explicitly teach the steps of:

b).   automatically determining claim breadth metrics for the multiple claims;

c).   associating said claim breadth metric with said claim text and storing said

associated metric in a computer-readable dataset; and

d).   wherein a claim breadth metric which is associated with a claim is

indicative of how broad the claim is.

Risen, however, teaches the step of valuation of the intellectual property asset is

the assignment of a monetary value to the intellectual property asset. This value can be

based upon the income and profits generated by the sale or use of the patented

technology, the number of remaining on the term of the patent, *the breadth of the*

claims, the nature of the patented technology, the nature of competitive products or processes etc. (col. 9, lines 20-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Risen's** teaching involves determining the breadth of the claim would have allowed **Snyder's** to provide the breadth metrics as a means for users to quickly identify the scope of the claimed subject matter together with other value asset factors in order to determine the suitable premium for insuring the intellectual property asset or assets as suggested by **Risen** at col. 9, lines 44-56.

Regarding claims 2 and 12, **Snyder** further teaches a step of analyzing the claim text includes counting the number of words in said claim text (col. 14, lines 36-59).

Snyder does not explicitly teach generating a claim breadth metric.

Risen, however, teaches the step of valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. This value can be based upon the income and profits generated by the sale or use of the patented technology, the number of remaining on the term of the patent, *the breadth of the claims*, the nature of the patented technology, the nature of competitive products or processes etc. (col. 9, lines 20-29).

Regarding claims 4, 14, and 18, **Snyder** further teaches a step of analyzing the claim text includes parsing said text to identify parts of speech (col. 13, lines 33-34),

using said identified parts of speech to identify clauses within said claim, comparing

said clauses with the text of other claims in said corpus to generate scores indicative of

which clauses within said claim text have a lower probability of being found in other

claims within said corpus (col. 3, lines 50-58; col. 4, lines 8-18; col. 17, line 65 – col. 18,

line 17).

Regarding claims 5 and 15, **Snyder** further teaches a step of displaying said

patent information in a sorted order (col. 27, lines 32-36).

Snyder does not explicitly teach display patent information based on claim

breadth metric.

Risen, however, teaches the step of valuation of the intellectual property asset is

the assignment of a monetary value to the intellectual property asset. This value can be

based upon the income and profits generated by the sale or use of the patented

technology, the number of remaining on the term of the patent, *the breadth of the*

claims, the nature of the patented technology, the nature of competitive products or

processes etc. (col. 9, lines 20-29).

Regarding claim 6, **Snyder** further teaches a step of analyzing the claim text

includes linguistically processing said text to identify at least one clause within said

claim text that has a lower probability than other of said clauses within said claim text of

being found in other claims within said corpus (col. 3, lines 29-31; col. 4, lines 49-62;

and col. 25, lines 7-25).

Regarding claims 7 and 19, **Snyder** further teaches a step of displaying said claim text such that said one clause is visually presented differently than the other of said clauses (col. 4, lines 12-16).

Regarding claim 11, **Snyder** further teaches a computer-implemented analysis method comprising:

a).   retrieving text of multiple claims from a computer-implemented data store, wherein the text of claims are from a plurality of patent documents (col. 4, lines 3-7 and lines 8-18);

Snyder further teaches analysis of structured documents such as claims within patents, accurately compare claims from two different patents in attempt to identify both the scope and references of the claims. Additionally, the system translate a set of claimlist text files which have been preprocessed into a single "mapit.wordvec.*.extr" file. This file consists of a list of each unique term in the original claimlist files followed by a count of the number of occurrences of that term for each document (col. 11, lines 22-28; col. 23, lines 42-45).

Snyder does not explicitly teach the steps of:

b).   automatically analyzing the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric that is associated with a claim is indicative of how broad the claim is.

c).   wherein the claim breadth metrics are used to analyze the multiple claims.

Risen, however, teaches the step of valuation of the intellectual property asset is

the assignment of a monetary value to the intellectual property asset. This value can be

based upon the income and profits generated by the sale or use of the patented

technology, the number of remaining on the term of the patent, *the breadth of the*

claims, the nature of the patented technology, the nature of competitive products or

processes etc. (col. 9, lines 20-29).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because **Risen's**

teaching involves determining the breadth of the claim would have allowed **Snyder's** to

provide the breadth and the scope of the claimed subject matter together with other

value asset factors in order to determine the suitable premium for insuring the

intellectual property asset or assets as suggested by **Risen** at col. 9, lines 44-56.

Regarding claim 16, **Snyder** further teaches a step wherein the sorted patent

documents are used in a patent infringement study (col. 4, lines 8-18).

Regarding claim 20, **Snyder** further teaches a step wherein the generated

descriptive statistics are indicative of quality of claims analyzed (col. 24, lines 4-20).

Snyder does not explicitly teach generating descriptive statistics based upon the

generated claim breadth metrics.

Risen, however, teaches the step of valuation of the intellectual property asset is

the assignment of a monetary value to the intellectual property asset. This value can be

based upon the income and profits generated by the sale or use of the patented

technology, the number of remaining on the term of the patent, *the breadth of the*

claims, the nature of the patented technology, the nature of competitive products or

processes etc. (col. 9, lines 20-29).

Regarding claim 21, **Snyder et al.** further teaches a step wherein generated

descriptive statistics are generated for groupings of claims (col. 24, lines 34-39).

Regarding claim 22, **Snyder** further teaches a step wherein the claim groupings

are formed based upon patent ownership, wherein the generated descriptive statistics

are statistics selected from the group consisting of average, average of the averages,

standard deviation, maximum, minimum, and combinations thereof (Fig. 8D).

Regarding claim 31, **Snyder** further teaches a computer-implemented patent

portfolio analysis apparatus comprising:

a).   a database of patent documents containing text of claims (col. 4, lines 3-

7);

c).   a cluster generator that analyzes patent information to generate category

metrics for the patent documents, wherein clusters of patent documents are determined

based upon the generated category metrics (col. 23, lines 10-41 and col. 24, lines 49-

62), wherein the clusters of patent documents are provided over an internet network for

use in analyzing the patent documents (col. 25, lines 40-58).

b).   **Snyder** does not explicitly teach a claim breadth analysis module that

analyzes the text of the claims in order to generate claim breadth metrics for the claims,

wherein a claim breadth metric is indicative of claim breadth of a claim, wherein the

claim breadth metrics are provided over an internet network for use in analyzing scope

of the claims.

Risen, however, teaches the step of valuation of the intellectual property asset is

the assignment of a monetary value to the intellectual property asset. This value can be

based upon the income and profits generated by the sale or use of the patented

technology, the number of remaining on the term of the patent, *the breadth of the*

claims, the nature of the patented technology, the nature of competitive products or

processes etc. (col. 9, lines 20-29).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because **Risen's**

teaching involves determining the breadth of the claim would have allowed **Snyder's** to

provide the breadth and the scope of the claimed subject matter together with other

value asset factors in order to determine the suitable premium for insuring the

intellectual property asset or assets as suggested by **Risen** at col. 9, lines 44-56.

Regarding claim 32, **Snyder** further teaches a computer-implemented patent

portfolio analysis apparatus comprising:

a).   a database of patent documents containing text of claims (col. 4, lines 3-

7);

c).   a cluster generator that analyzes patent information to generate category
metrics for the patent documents, wherein clusters of patent documents are determined
based upon the generated category metrics (col. 23, lines 10-41 and col. 24, lines 49-
62), wherein the clusters of patent documents are provided over an internet network for
use in analyzing the patent documents col. 25, lines 40-58).

b).   **Snyder** does not explicitly teach a claim breadth analysis module that
automatically analyzes the text of the claims in order to generate claim breadth metrics
for the claims, wherein a claim breadth metric is indicative of claim breadth of a claim,
wherein the claim breadth metrics are provided over an internet network for use in
analyzing scope of the claims.

Risen, however, teaches the step of valuation of the intellectual property asset is
the assignment of a monetary value to the intellectual property asset. This value can be
based upon the income and profits generated by the sale or use of the patented
technology, the number of remaining on the term of the patent, ***the breadth of the
claims***, the nature of the patented technology, the nature of competitive products or
processes etc. (col. 9, lines 20-29).

It would have been obvious to one of ordinary skill in the art at the time of the
invention was made to combine the teachings of the cited references because **Risen's**
teaching involves determining the breadth of the claim would have allowed **Snyder's** to
provide the breadth and the scope of the claimed subject matter together with other
value asset factors in order to determine the suitable premium for insuring the
intellectual property asset or assets as suggested by **Risen** at col. 9, lines 44-56.

4.   Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Snyder et al. ("Snyder") (U.S. Patent 6,038,561) in view of **Risen, Jr. et al. ("Risen")**

(U.S. Patent 6,018,714) as applied to claims 1-2, 4-7, 11-12, 14-16, 18-22, and 31-32

above and further in view of **Newman** (U.S. Patent 5,774,833).

Regarding claims 3 and 13, **Snyder** and **Risen** do not explicitly teaches a step

wherein said step of analyzing the claim text includes identifying within said claim text a

preamble portion and a body portion, counting the number of words in said preamble

and body portions and applying separate weights to said count to generate said claim

breadth metric.

Newman, however, teaches analysis of patent text and drawings. The analysis

can be applied to the Detailed Description of the Drawings by counting the frequency of

the use of words "may" or "might" and verify that no more than 150 words are used (col.

8, lines 65-67; col. 13, lines 39-46).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because

Newman's teaching would have allowed **Snyder- Risen's** to count the number of

words in the claim in order to asset the similarity and scope of the patent claims and

assign scores to the compared claims accordingly to facilitate identification of claim

categories. Further, it should be noticed that counting the number of words in said

preamble and body portions and applying separate weights to said count to generate

said claim breadth metric is well-known in the field of Patent claim drafting. In this

present case, the ordinary skill in the art would have known that the breadth of a claim

is inversely proportional to the quantity of limitations recited therein.

5.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder
et al. ("Snyder")**(U.S. Patent 6,038,561) in view of **Risen, Jr. et al. ("Risen")** (U.S.
Patent 6,018,714) as applied to claims 1-2, 4-7, 11-12, 14-16, 18-22, and 31-32 above
and in view of **Rivette et al. ("Rivette")**(U.S. Patent 6,339,767 B1).

Regarding claim 17, **Snyder** does not explicitly teach a step wherein the sorted

patent documents are used to determine patent documents whose maintenance fees

are not to be paid.

Rivette, however, teaches a step wherein the Financial Modules perform patent-

centric and group-oriented processing of the data in the financial database. Examples

of the functions performed by the financial modules include determining the research

and design expenditures, determining maintenance fees, and determining cumulative

product revenue on a product or product line basis, etc. (col. 94, lines 23-43).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because **Rivette's**

teaching would have allowed **Snyder- Risen's** to project various types of costs on

certain products or licensing revenue associated with any patent own by the company at

suggested by **Rivette** at col. 94, lines 62-64.

Response to Argument

6.   Applicant's arguments filed 06 August 2004 have been fully considered but they

are not persuasive.

Applicants argue that Risen did not teach "**automatically determining**" claim

breadth metrics, as the Examiner has presumed and that the prior art teaches away

from Applicants' invention.

In response to the preceding arguments, Examiner respectfully submits that it

has been held that broadly providing an automatic or mechanical means to replace a

manual activity which accomplished the same result is not sufficient to distinguish over

the prior art. See MPEP 2144.04 section III, In re Venner, 262 F.2d 91, 95, 120 USPQ

193, 194 (CCPA 1958).

> III. AUTOMATING A MANUAL ACTIVITY
>
> In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)
> (Appellant argued that claims to a permanent mold casting apparatus for
> molding trunk pistons were allowable over the prior art because the
> claimed invention combined "old permanent-mold structures together with
> a timer and solenoid which automatically actuates the known pressure
> valve system to release the inner core after a predetermined time has
> elapsed." The court held that broadly providing an automatic or
> mechanical means to replace a manual activity which accomplished the
> same result is not sufficient to distinguish over the prior art.).

Further, it is submitted that the Risen reference does not teach away from the

invention because it would have been obvious to one of the skilled in art at the time of

the invention was made to automate a manual activity to accomplish the same result [In

re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)]. Applicants are

reminded that in order to disqualify a reference based on a "teach away" reasoning, the

reference has to *explicitly* suggest or disclose the so-called teach away steps –

Applicants assertion can not be accepted if it is unsupported by a valid evidence.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Leslie Wong whose telephone number is (571) 272-

4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John E Breene can be reached on (571) 272-4107. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.
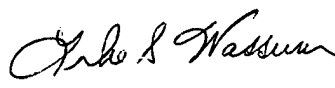
Information regarding the status of an application may be obtained from the

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Leslie Wong
Patent Examiner
Art Unit 2167

LW
February 4, 2005

Primary Examiner